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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re LesConcierges, Inc.

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Serial No. 75/044,642

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Peter K. Hahn of Luce, Forward, Hamilton & Scripps LLP for  
LesConcierges, Inc.

Lisa W. Rosaya, Trademark Examining Attorney, Law Office  
112 (Janice O'Lear, Managing Attorney).

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Before Cissel, Bottorff and Quinn, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 17, 1996, the above-identified applicant  
applied to register the mark "LESCONCIERGES" on the  
Principal Register for "personal services, namely providing  
personal errand, appointment, meeting planning, party and  
special event planning, reservation, shopping and travel  
planning services for others," in Class 42. The basis for  
the application was applicant's claim that it had used the  
mark in connection with these services as early as October

of 1987 and that the mark had been used in connection with such services rendered by applicant in interstate commerce at least as early as February 21, 1991.

In addition to pointing out some informalities that needed to be resolved, the original Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, as used in connection with the services set forth in the application, so resembles the mark shown below,

which is registered,<sup>1</sup> with a disclaimer of "LA CONCIERGE," for "party planning services," in Class 41, that confusion is likely.

At applicant's request, action on the application was suspended pending resolution of applicant's petition to cancel the cited registration. That proceeding was resolved after the respondent therein assigned the

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<sup>1</sup> Reg. No. to 1,790,757, issued on August 31, 1993 to Josephene B. Hanlon, an individual, based on a claim of use in commerce since March 15, 1992.

registration to applicant.

Along with its request to lift the suspension, applicant provided a response to the earlier Office Action. Applicant amended the recitation of services to read as follows: "making reservations and bookings for transportation for others," in Class 39; and "party and special event planning and arranging for ticket reservations for shows and other entertainment events," in Class 41. In response to the Examining Attorney's request for a translation of the mark, applicant provided an English dictionary definition of the word "concierge" as "a resident of an apartment building, especially in France, who serves as a doorkeeper, landlord's representative, and janitor," and as "a multilingual hotel staff member, especially in Europe, who handles luggage and mail, makes reservations, and arranges tours for guests." Applicant's response also stated that "[t]he mark applied for herein is the plural of the word 'concierge.'"<sup>2</sup>

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<sup>2</sup> Although the typed drawing submitted with this application shows the mark as "LESCONCIERGES," the specimens of use show it as it appears in applicant's trade name, "LesConcierges," a telescoped version of the two words, with no space between the article "Les" and the plural noun "Concierges." At no time has applicant argued that because of the omission of the space between the two words, the term it seeks to register has any significance other than as the plural of the word "concierge."

Along with the response and amendment, additional specimens were submitted in support of the services in Class 39. The specimens are copies of what appear to be the same advertisement applicant originally submitted in support of the services in Class 42. In the advertisement, applicant describes itself as "the country's leading executive concierge service."

In his next Office Action, the original Examining Attorney withdrew the refusal under Section 2(d) of the Lanham Act, but refused registration under Section 2(e)(1) of the Act on the ground that applicant's mark is merely descriptive of the services set forth in the application, as amended. Further, the Examining Attorney stated that the term sought to be registered is generic in connection with the services and is therefore incapable of identifying applicant's services and distinguishing them from similar services provided by others. Accordingly, the Examining Attorney advised applicant against amending to seek registration under Section 2(f) of the Act or amendment to seek registration on the Supplemental Register.

Attached to the Office Action were copies of excerpts from published articles, retrieved from the Nexis® database, wherein the term "executive concierge" is used in reference to an individual who runs errands and performs

other personal services for clients. The Examining Attorney submitted this excerpt to show that while the traditional significance of "concierge" relates to a person who works for a hotel or an apartment or an office, the term has come to identify anyone who renders the same kinds of personal services, even those who are not tied to any particular location, but instead serve the public at large.

Applicant responded to the refusal to register under Section 2(e)(1) with argument that the term it seeks to register is not merely descriptive of the services set forth in the amended application. In the alternative, applicant sought registration under Section 2(f) of the Act based on a claim of acquired distinctiveness. Applicant contended that the Examining Attorney had improperly dissected the mark, but that even if such dissection were allowed, the fact that some of the meanings attributable to the word "concierge," such as a hotel employee or a person who works in an apartment building, do not describe applicant's services results in the term sought to be registered having a double entendre, so that applicant's mark is nonetheless registerable. Further, applicant argued that its recently acquired registration was obtained without resort to a claim of distinctiveness, and that if "LA CONCIERGE" is not merely descriptive of applicant's

services, "LESCONCIERGES" is not merely descriptive of them either. Applicant submitted materials in support of its acquired distinctiveness claim, including the declaration of Jane Winter, its president, who provided information about applicant's use of the mark in connection with the services since 1987 and figures regarding the promotion and sales of applicant's services under the mark.

Additional advertising materials were also attached to this response. On the first page of the brochure submitted, applicant advises that "in these pages you will learn how your personal concierge can manage so many of your business and personal needs." In the second advertisement submitted, applicant states that "LesConcierges is not only the world's leading executive concierge organization, but it's also a brilliantly effective tool." In another advertisement, applicant again touts "LesConcierges" as "the country's leading executive concierge service." Yet another advertisement invites customers "to speak with a concierge" by calling applicant's toll-free number.

A new Examining Attorney was assigned to the application, but he was not persuaded by applicant's arguments or by the attachments to applicant's response. He maintained that the term applicant seeks to register is

generic for the services identified in the amended application, and therefore that no amount of evidence in support of applicant's claim of acquired distinctiveness would be sufficient to establish that the term is registerable.

Many additional excerpts from articles retrieved from the Nexis® database were included with this action by the new Examining Attorney. In these excerpts, the term "concierge" is used to identify both the occupation of concierges and also the services they render, including making reservations, acquiring tickets, and other personal services. Although some of these excerpted stories clearly refer to applicant and its services, the terms "concierge," "concierges" and "concierge service" are clearly used as generic terms in connection with making reservations and the other personal assistant types of services generally characterized by the terms.

Also submitted with this Office Action were copies of Office records of a number of third-party registrations wherein "concierge services" are listed as the services in connection with which the various registered marks are used.

Applicant's response was to maintain that the term sought to be registered is not merely descriptive of

applicant's services, but that even if it were held to be merely descriptive of them, the term has acquired distinctiveness based on years of exclusive and continuous promotion and use. Applicant argued that there is no evidence that "LESCONCIERGES" is used by anyone other than applicant, and submitted dictionary excerpts and Internet and yellow pages directory evidence in support of this argument. Applicant also submitted a list of third-party registered marks which applicant claimed include the term "concierge" without claims of distinctiveness under Section 2(f). Applicant contended that in view of these registrations, there should be a "strong presumption" that the term "concierge" is not generic.

Citing *In re Johanna Farms, Inc.*, 8 USPQ2d 1408 (TTAB 1988), applicant argued that a mark combining a foreign language article with a term found in an English dictionary does not result in a generic term. Applicant repeated its arguments that its mark is registerable because it creates a double entendre, that applicant has met the test for acquired distinctiveness, and that its ownership of the above-referenced registration for "La Concierge" and design is proof that "LESCONCIERGES" has acquired distinctiveness.

The Examining Attorney remained unpersuaded by applicant's arguments and submissions. The refusal under



Section 2(e)(1) of the Act on the ground that the term applicant seeks to register is generic, and hence incapable of identifying applicant's services and distinguishing them from similar services rendered by others, was repeated and made final, and applicant's claim of acquired distinctiveness was rejected. The Examining Attorney included additional dictionary definitions showing that concierges are caretakers or managers and that "les" is the French plural for the article "the." Additionally, he made of record a stack of third-party registrations wherein the services with which the registered marks are used are identified as "concierge services."

Applicant timely filed a notice of appeal, followed by an appeal brief. Yet another Examining Attorney was assigned this application, and she timely filed her brief on appeal, to which applicant filed a timely response. Applicant did not request an oral hearing before the Board, so we have resolved this appeal based upon consideration of the written record and arguments in this application file. Based on careful consideration of these materials, we hold that the refusal to register is appropriate because the term sought to be registered is incapable of identifying and distinguishing applicant's services.

Both applicant and the Examining Attorney agree with respect to the tests for determining registrability under Section 2(e)(1) of the Lanham Act. A mark is descriptive of the products or services with which it is used if the mark describes or immediately conveys information about a characteristic, function, feature or purpose of the goods or services. In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). As our primary reviewing court stated in H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986): "a generic term is the common descriptive name of a class of goods or services, and, while it remains such common descriptive name, it can never be registered as a trademark because such a term is 'merely descriptive' within the meaning of Section 2(e)(1) and is incapable of acquiring de jure distinctiveness under Section 2(f). The generic name of the thing is in fact the ultimate in descriptiveness." A generic designation or one which is so highly descriptive as to be incapable of appropriation as a trademark or service mark may not be rendered registerable even though it may be associated in the minds of many customers as an indicator of the source of the goods or services offered by a particular enterprise. In re Minnetonka, Inc., 212 USPQ 772 (TTAB

1982); Weiss Noodle Co. v. Golden Cracknel & Specialty Co.,  
129 USPQ 411 (CCPA 1961).

Generic names are not registerable. In a similar sense, highly descriptive terms which are not necessarily the apt or common names of the goods or services in question have been held incapable of being appropriated as trademarks or service marks. In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999). A term which names the people who perform the activity which constitutes the service is incapable of serving as a service mark for those services. In re Industrial Relations Counselors, Inc., 224 USPQ 309 (TTAB 1984) ["Industrial Relations Counselors" held to be an apt name for "educational services, namely conducting seminars and research in the field of industrial relations"].

Obviously, practitioners of any profession or vocation should be allowed to identify themselves accurately, e.g., movers must be free to call themselves movers, teachers need to be able to use the word "teachers" in reference to themselves, and painters should not have their collective name removed from the lexicon of terms available for their descriptive use. In the same sense, the concierges in our society are entitled to identify themselves as the

concierges, or, as in the case at hand, by using the French form of this plural noun.

The record in the instant application clearly establishes that the term applicant seeks to register, which applicant itself characterizes as "the plural form of 'concierge,'" is used to identify a service which applicant itself describes in its advertising as a "concierge service," rendered by "your personal concierge."

The term applicant has applied to register, as the plural form of "concierge," is incapable of serving to identify applicant's concierge services or distinguishing them from concierge services rendered by other entities. Applicant's own generic use of the singular form of the term it seeks to register is strong evidence that the term is generic and therefore unregistrable, even if some degree of de facto significance as a mark could be established. In addition to applicant's use of "concierge" and "concierge services" as generic terms for applicant's services, the record, as noted above, is replete with evidence that "concierge services" is the apt descriptive name for what applicant does under the designation it seeks to register.

None of applicant's arguments is persuasive of a finding that this designation is capable of functioning as

a service mark for the kinds of concierge services set forth in this application. The argument that the mark creates a double entendre because the dictionary definitions of "concierge" include references to workers in apartments and hotels is particularly unavailing. The record, as noted above, clearly establishes that applicant provides concierge services under the term it seeks to register. That concierge services are offered to apartment dwellers and hotel guests does not make the plural form of the word "concierge" any less generic in connection with these services. Similarly, applicant's contention that its ownership of Reg. No. 1,790,757 for the mark "LA CONCIERGE" and design entitles applicant to registration in the case at hand is not well taken. As noted above, this descriptive terminology is disclaimed in that registration. This hardly converts the plural form of "concierge" into a registrable service mark.

Additionally, applicant maintains that because it was unable to find any listings for the combined term "LESCONCIERGES" in various reference sources, the term cannot be held to be unregistrable under Section 2(e)(1) of the Act. As noted above, applicant itself characterizes the term it seeks to register as the plural form of "concierge," and promotes its services as "concierge

services." In the face of these facts, that applicant could not locate references to the telescoped term "LESCONCIERGES" is irrelevant.

Applicant's contention that the term it seeks to register is capable of functioning as a service mark for applicant's services because it consists of a combination of a French article and a term found in an English dictionary is without merit. Although that is one way the result in the case cited by applicant could be characterized, it is certainly not the rule established by that case. There, the Board was presented with "LA YOGURT," but the record showed that "YOGURT" was, in fact, an English language word which was not the French word for "yogurt," but instead, "a corruption" of it. In the instant case, however, both the plural article "LES" and the word "CONCIERGES" are French terms, notwithstanding that "CONCIERGES" has become a recognized word in English as well. As applicant admitted, the term it seeks to register is the plural of "concierge," and applicant's own advertisements make it clear that applicant provides concierge services, rendered by concierges.

Lastly, applicant argues that the list of third-party registrations of marks which contain the word "concierge" establishes the registrability of the term "LESCONCIERGES."

As the Examining Attorney points out, however, applicant's submission of the list did not make the registrations referred to in it of record, and moreover, even if that were the case, such registrations would not have the effect of binding the Examining Attorney or the Board in the case at hand. We would not have had the records in the applications which matured into those registrations, so we would not have had a basis upon which to determine why they were issued. In any event, it is well settled that each case must be decided on its own merits, based on its own record and facts. The record before us in this appeal provides no basis upon which we could conclude that the term herein sought to be registered serves as an identification of the source of the services set forth in the application.

In summary, the record before us in this appeal establishes that the term applicant seeks to register is so highly descriptive of the services in connection with which it is used that it is incapable of identifying the source of applicant's services and distinguishing them from services of similar nature rendered by others. Accordingly, the mark is unregistrable under Section 2(e)(1) of the Lanham Act,

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and applicant's claim of acquired distinctiveness under Section 2(f) of the Act must necessarily be rejected. The refusal to register is affirmed.

R. F. Cissel

T. J. Quinn

C. M. Bottorff  
Administrative Trademark Judges  
Trademark Trial & Appeal Board



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